RESPONSE

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 13-32 the only claims pending and currently under examination in this application.

Formal Matters

Claims 13-32 are pending after entry of the amendments set forth herein

Claims 13 and 14 were examined. Claims 13 and 14 were rejected. No claims were allowed.

Claims 1-12 have been cancelled without prejudice.

Claims 13 and 14 have been amended. Support for the amendment can be found in the claims as originally filed and throughout the specification at, for example: page 16, lines 5-18, page 17, lines 24-29, and Figures 1A, 1B, 2A, and 2B.

New claims 15-32 have been added. Support for the new claims can be found in the claims as originally filed and throughout the specification at, for example: claim 21: original claims 1 and 14; claim 22: original claim 2; claim 23: original claim 3; claim 24: original claim 4; and claim 25: original claim 5.

As the above amendments introduce no new matter to the application, their entry is respectfully requested.

Restriction Requirement

The Applicants hereby confirm the election to prosecute the invention of Group II, claims 13 and 14, as made on October 13, 2005.

Objections

Abstract

The disclosure has been objected to because the abstract is divided into two paragraphs. In view of the amendments of the specification, this objection may be withdrawn.

Specification

The disclosure has been objected to because the specification allegedly fails to provide proper antecedent basis for the claimed subject matter. In particular, the Office Action objects to the phrase "to quench the quencher molecule" of claim 14 as lacking antecedent basis in the specification. In view of the amendment to claim 14, this objection may be withdrawn.

Rejection under 35 U.S.C. §112, second paragraph

Claim 14 has been rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action objects to the phrase "to quench the quencher molecule".

In the spirit of expediting prosecution and without conceding to the correctness of the rejection, claim 14 has been amended to recite "to quench the **excitable** molecule". Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. §112, first paragraph

Claim 14 has been rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains. In particular, the Office Action objects to the phrase "to quench the quencher molecule".

In the spirit of expediting prosecution and without conceding to the correctness of the rejection, claim 14 has been amended to recite "to quench the **excitable** molecule". Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. §102

Claim 13 has been rejected under 35 U.S.C. §102 (b) for allegedly being anticipated by WO 01/18247 (WO '247). In view of the amendments to the claims and the remarks made herein, this rejection is respectfully traversed.

The present invention is directed to a structure for sensing a portion of a nanoscale moiety, comprising providing a substrate having an excitable molecule adjacent to a nanopore; and moving a portion of a nanoscale moiety with a quencher molecule past the excitable molecule to quench the excitable molecule and determine the identity of the portion of the nanoscale moiety.

In contrast, the cited reference WO '247 is directed to a method for analyzing polymer molecules by detecting the effect of the polymer molecule on an optical agent associated with a nanopore, wherein the nucleic acid polymer itself serves as a quencher molecule with each base performing a quenching action on the excited fluorophore (see page 35 of WO '247 and Office Action, page 9). Nowhere does WO '247 teach a method of analyzing a polymer wherein the polymer further comprises a separate quencher molecule.

In the spirit of expediting prosecution and without conceding as to the correctness of the rejection, claim 13 has been amended for clarification to further recite "wherein the quencher molecule is different from the nanoscale moiety". Support for the amendment can be found in the claims as originally filed and throughout the specification at, for example, page 16, lines 5-18, page 17, lines 24-29, and Figures 1A, 1B, 2A, and 2B.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

Since WO '247 does not teach a method of analyzing a nanoscale moiety in which the quencher molecule is different from the nanoscale moiety that is employed, the cited reference fails to disclose every element found in the claims of the present invention. As such, claim 13 is not anticipated under 35 U.S.C. § 102 by the cited reference. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Finally, new claims 15-32 are patentable for at least the same reasons provided above.

CONCLUSION

The Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

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